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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,698	11/29/2001	Andrew C. Gilbert		2615

7590 12/24/2009
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EXAMINER

KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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12/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/995,698	Applicant(s) GILBERT ET AL.	
	Examiner STEFANOS KARMIS	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10 and 17-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10 and 17-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/25/09, 9/9/09, 12/16/09</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01 September 2009 has been entered.

Status of Claims

2. Claims 1, 17, 34, 45, 56, and 57 are currently amended. Claims 58-65 are newly added. Claims 1-7, 10, 17-65 are pending.

Response to Arguments

3. Applicant's amendment, cancelling claim 11 is sufficient to overcome the previous claim objection. Therefore the objection is withdrawn.

4. Applicant's arguments filed 01 September 2009, with respect to the rejection under 35 U.S.C. 112, first paragraph have been fully considered and are persuasive. Therefore the previous grounds of rejection under 35 U.S.C. 112, first paragraph is withdrawn.

5. Applicant's arguments filed 01 September 2009, with respect to the rejection under 35 U.S.C. 102 have been fully considered and are not persuasive

Art Unit: 3693

Regarding claim 1, Applicant argues that Woodmansey fails to disclose the amended limitation of receiving a parameter from a user designating a relationship specifying the timing at which the bid and offer are to be brought to market, including specification of a time interval between the times that the bid and offer are to be brought to market relative to each other, the timing relationship with its time interval between the bid and offer being enforced by the trading system. Specifically, Applicant argues that Woodmansy fails to disclose specification of a time interval between the times that the bid and offer are to be brought to market relative to each other and argues that the delay feature in Woodmansy is measured from the time the user submits the order and are therefore not relative to each other. The Examiner respectfully disagrees with Applicant's argument that Woodmansy fails to disclose such a feature.

Woodmansy discloses that a user may select linking parameters for bids and offers after the trader has selected items to be linked (column 5, lines 37-48). Woodmansy further discloses that the user can specify a sequencing requirement and order placement delays as well as other parameters (column 5, lines 49-58 and Figure 5; Examiner notes that multiple requirements can be set at once, i.e. both a sequencing and delay). When the user selects the sequencing linking parameters, the user can fill in a numerical sequence of placement for the orders, thus allowing orders for item 1 to always be placed before other orders (column 6, lines 3-26 and Figure 5, fixed). Further, Woodmansy discloses that that the user can sequence the orders by age and size and so that the older larger orders will (column 6, lines 3-26 and Figure 5, see sequencing, variable). Therefore, Woodmansy discloses brining orders to market relative to each other.

Woodmansy also discloses a delay feature that can be applied in conjunction with the sequencing feature. In the delay feature, a trader can cause the placement of an order to be

Art Unit: 3693

delayed by a time interval, such as 1 minute (column 6, lines 34-41). Therefore, Woodmansy discloses a time interval. When it comes time to submit the order, the system checks to determine sequencing of the order as well as delay and if so, puts the orders on hold (column 9, lines 3-18). An order can be on hold if it is not ready to be submitted based on the sequencing and delay parameters (column 7, lines 11-29). Therefore the sequencing and delay parameters must be satisfied prior to the order being ready to be brought to market (column 9, lines 3-18). Thus, when the order gets processed, it must first satisfy the sequencing (relative to each other) and delay (time interval) parameters prior to being brought to market (column 7, lines 11-29 and column 9, lines 3-18). As an example of the invention, order 1 could be sequenced to placed prior to order 2 and order 2 could also have a 60 second delay, as discussed above. Therefore, order 1 is brought to market prior to order 2, and after order 1 is brought to market, order 2 must wait 60 seconds before being ready for submission. As another example, order 1 could be sequenced prior to order 3, but order 1 and order 3 may not have any delay, and thus order 1 and order 3 may be submitted substantially simultaneously, with order 1 being submitted prior.

Therefore Woodmansy discloses specification of a time interval between the times that the bid and offer are to be brought to market relative to each other. For this reason, Applicant's arguments with respect to claim 1 are not persuasive. As noted by Applicant, the arguments regarding claims 17, 34, 45, and 56 are similar to claim 1 and therefore the same reasoning as discussed for claim 1 above.

6. Newly added claims 58-65 are addressed below.

Art Unit: 3693

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-7, 10, 17-60, and 62-64 are rejected under 35 U.S.C. 102 (e) as being anticipated by Woodmansey et al. US Pat. No. 7,155,410 B1, (hereinafter “Woodmansey”).

Claims 1-3, 10, 31-33, 42, 43, 54, 55, Woodmansey discloses a method for use in an electronic trading system, the method comprising the acts of:

receiving a bid at the electronic trading system (abstract, column 3, lines 56-67);

receiving at the electronic trading system a designation of a linking parameter linking the bid to an offer based on historical market data (column 8, lines 41-47), and generating an offer based at least in part on the received bid and the received designated linking parameter (abstract, column 2, lines 40-50, column 5, lines 37-48);

receiving a parameter from a user designating a relationship specifying the timing at which the bid and offer are to be brought to market, including specification of a time interval between the times that the bid and offer are to be brought to market relative to each other, the timing relationship with its time interval between the bid and offer being enforced by the trading

Art Unit: 3693

system (column 5, lines 37-48, fig. 5, element 512, column 6, lines 6-41, and column 11, lines 5-8; Examiner also notes the arguments section which discusses this feature in detail).

Claims 4-7, and 49, Woodmansey discloses the steps of prompting a user to input the linking parameter (fig. 2A, element 204, and column 5, lines 37-48), generating a price spread between the bid and the offer, generating a size of the offer based on a size of volume spread between the bid and the offer, and generating a price spread and a size of the offer based on a size of volume spread between the bid and the offer (column 2, lines 58-65, column 4, line 46 thru column 5, line 20).

Claims 17, 34, 35, 44, 45, and 56, Woodmansey discloses a method and computer readable medium programmed to cause an electronic trading system to:

generating an electronic record of an order to trade on behalf of a trader on a market implemented in an electronic trading system (abstract, column 3, lines 56-67);

generating an electronic record of a counter-order to trade on behalf of the same trader, the counter-order having a parameter linked to a parameter of the order (abstract, column 2, lines 40-50, column 5, lines 37-48); and

receiving a parameter from a user designating a relationship specifying the timing at which the order and counter-order are to be brought to market, including specification of a time interval between the times that the order and counter-order are to be brought to market relative to each other, the timing relationship with its time interval between the order and the counter-order

Art Unit: 3693

being enforced by the trading system (fig. 5, element 512, column 6, lines 2-41, and column 11, lines 5-8; Examiner also notes the discussion in the arguments section regarding this feature).

Claims 18 and 19, Woodmansey discloses that the order is a bid to buy, and the counter-order is an offer to sell and the order is an offer to sell, and the counter-order is a bid to buy (column 1, line 60 thru column 2, line 57).

Claims 20-22, 36, 37, 46-48, Woodmansey discloses that the linking of the parameters is performed at the explicit request of the trader as the counter-order is entered (abstract), the electronic trading system provides to the trader a screen display interface for entering the order and counter-order, and the screen display interface has the capability of prompting the trader to enter the order and counter-order as linked bid and offer (fig. 3).

Claims 23-25, 38 and 50, Woodmansey discloses that the parameters of the order and counter-order to be linked are detected at least in part automatically by the electronic trading system; the electronic trading system issues a prompt to the trader to link the order and counter-order, wherein the counter-order is generated at least in part automatically by the electronic trading system in response to the generating of the order (abstract, column 2, lines 40-50, column 5, lines 37-48).

Art Unit: 3693

Claims 26 and 27, Woodmansey discloses that the order and counter-order are for items that are the same as each other, in the sense of being fungible instances of the item (column 5, lines 21-57).

Claims 28-30, 39-41 and 51-53, Woodmansey discloses that the size of the counter-order is linked as a function of the size of the order, the price of the counter-order is linked as a function of the price of the order, and the size of the counter-order is linked as a function of the price of the order (column 2, lines 3-15, column 6, line 59 thru column 7, line 29 and column 8, line 65 thru column 9, line 58).

Claims 57, 58 and 62, wherein the timing relationship specifies that the order and the counter-order are to be brought to market substantially simultaneously to each other (column 6, lines 3-26 and 34-41; Examiner also notes the arguments section which addresses this feature).

Claims 59, and 63, wherein the time interval is a non-zero time interval between the time at which the order and counter order are to be brought to market (column 6, lines 34-41; Examiner also notes the arguments section which addresses this feature).

Claims 60 and 64, wherein the non-zero interval is configured by the user (column 6, lines 34-41).

Art Unit: 3693

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 61 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woodmansey et al. US Pat. No. 7,155,410 B1, (hereinafter “Woodmansey”) in view of Official Notice.

Claims 61 and 65, Woodmansey teaches that the user sets the non-zero interval by inputting a time, such as 10 seconds or 60 seconds (column 6, lines 34-41). Woodmansy fails to teach that the time interval is set by the electronic trading system. Official Notice is taken that having the system set parameters is old and well known in the electronic trading arts. Therefore it would have been obvious to a person of ordinary skill in the art at the time of the Applicant’s invention to modify the teaching of Woodmansey for the user setting the time interval to specify that the system sets the time interval because it provides for easier tracking and placement of

Art Unit: 3693

orders by providing less options to the user and thus provide for quicker user selection of the delay and faster processing of order parameters. Therefore the system could provide default time intervals, such as 60 seconds and only allow the user to select whether they would like the delay.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEFANOS KARMIS whose telephone number is (571)272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted
/Stefanos Karmis/
Primary Examiner, Art Unit 3693
24 December 2009